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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,719	01/17/2002	Richard Hsiao	SJO9-2001-0046US1	1405
32112	7590	05/21/2004	EXAMINER	
INTELLECTUAL PROPERTY LAW OFFICE 1901 S. BASCOM AVENUE, SUITE 660 CAMPBELL, CA 95008			TUPPER, ROBERT S	
			ART UNIT	PAPER NUMBER
			2652	10

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,719

Applicant(s)

HSIAO ET AL.

Examiner

Robert S Tupper

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 4, 11-20 and 24-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/17/02.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. Applicant's election without traverse of the invention of Group I and the species of figures 5-14, indicating claims 1-3, 5-10, and 21-23 as readable thereon, in Paper No. 9 of 3/9/04 is acknowledged.

2. Claims 4, 11-20, and 24-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, on line 1, "said etch stop layer" has no antecedent basis.

Concerning claims 7-10, the recitation in claim 7 on line 12 "a write gap layer being disposed above said fill layer" is indefinite, misleading, and misdescriptive. The positions of these layers is unclear. This recitation can be read that there are two separate layers, a gap layer and a fill layer, above the coil insulation layer. There is only one layer above the coil insulating layer, the write gap layer.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5-8, and 21-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by SANTINI (6,130,809).

Note especially figures 1-4, 18, 19,29, and 32. SANTINI shows a thin film magnetic head (250) used in a disk drive (see figures 1-3), the head is mounted on a substrate (the slider 42) and has a first pole(254) with a pole pedestal (262), an etch stop layer 266), a coil (252), electrical insulation layer (268) between coil layers where the coil insulating layer does not extend to the ABS surface, a fill/write gap layer (276 and not numbered thin top layer) located above the coil insulating layer which has portions that extend to the ABS surface to provide the write gap, and a second pole (not shown in figure 19, but shown in the two layer coil embodiment of figure 18 as P2/S1). The insulating layers are disclosed as utilizing either alumina or silicon dioxide (see column 12 lines 32-35).

7. Claims 9 and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

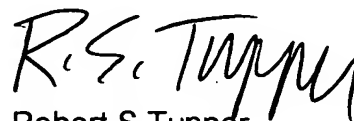
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SASAKI, YARZAWA et al, and KOBAYASHI et al all show thin film heads with a coil insulating layer that does not extend to the ABS surface and separate fill/gap/etch stop layers above and below the coil insulting layer, where portions of those layers extend to the ABS surface. These have not been applied against the pending claims to avoid cumulative rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert S Tupper whose telephone number is 703-308-1601. The examiner can normally be reached on Mon - Fri, 6:00 AM - 3:30 PM (first Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 703-305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Robert S Tupper
Primary Examiner
Art Unit 2652